Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY STEWART

Appeal No. 1998-0040
Application No. 08/068,753

ON BRIEF

Before WARREN, WALTZ and KRATZ, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 20-27, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to a parylene deposition system including a specified arrangement of a dimer vaporization chamber and a pyrolysis chamber in a housing and a selectively attachable/detachable deposition chamber module

thereto. The deposition chamber module includes a base cabinet and a deposition chamber attached to the base cabinet. An understanding of the invention can be derived from a reading of exemplary claim 20, which is reproduced in an appendix attached to appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Gallego 4,592,306 Jun. 03, 1986

Wanlass 4,649,859 Mar. 17, 1987

Riley 4,683,143 Jul. 28, 1987

Takahashi et al. (Takahashi) 4,825,808 May 02, 1989 Rubin et al. (Rubin) 4,852,516 Aug. 01, 1989

Sakamoto et al. (Sakamoto)[1] 59074629 Apr. 27, 1984 (published Japanese Kokai Patent Application)

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[1] All references to Sakamoto in this decision are to the English language translation thereof of record, a copy of which is enclosed with the decision.

Oba et al. (Oba)[2] 59133335 Jan. 22, 1986
(published Japanese Kokai Patent Application)

Claims 20-25 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Riley in view of Rubin, Gallego and Takahashi. Claim 26 stands rejected under 35 U.S.C. § 103 as being unpatentable over Riley in view of Rubin, Gallego and Takahashi and further in view of Sakamoto, Toshiba and Wanlass.

OPINION

Upon careful consideration of appellant's specification and the claims on appeal, the evidence of obviousness relied upon by the examiner, and the opposing arguments presented by appellant and the examiner, we find that the aforementioned § 103 rejections are not well founded. Accordingly, we will not sustain the examiner's rejections.

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[2] All references to Oba in this decision are to the English language translation thereof of record, a copy of which is enclosed with the decision.

We agree with the examiner (answer, page 4) that Riley teaches the use of separate vapor generating and deposition chambers and that the claims on appeal are not limited to a particular type of attachment between the claimed modules based on the relative ease of attachment and detachment. Nonetheless, we point out that in a rejection under 35 U.S.C. § 103, it is fundamental that all elements recited in each claim must be considered and given appropriate effect by the examiner in judging the patentability of that claim against the prior art. *See In re Geerdes*, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791 (CCPA 1974). Here, the examiner's rejection set forth in the answer fails to meet that basic test for the presentation of a sustainable § 103 rejection.

In this regard, we note that all of the claims on appeal require that the pyrolysis chamber and the vaporization chamber are disposed within a housing. Moreover, each of the appealed claims requires that the deposition chamber module includes a deposition chamber attached to a base cabinet. See independent claims 20[3] and 27.

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[3] While we find that claim 20 is sufficiently definite to resolve the merits of the § 103 issues raised on this appeal,

The examiner has failed to provide any support for the statement that "it would have been obvious to place these parts in a cabinet below the deposition chamber" (answer, page 3). Nor has the examiner fairly explained why the disparate teachings of Rubin, Gallego and Takahashi would have led one of ordinary skill in the art to modify the apparatus of Riley so as to arrive at the claimed subject matter, including the above-noted limitations. "It is well established that before a conclusion of obviousness may be made based on a combination of references, there must have been a reason, suggestion or motivation to lead an inventor to combine those references." *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.,* 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996). The examiner has only made general statements regarding the vapor coating art and alleged advantages of modular construction taught by Rubin, Takahashi and Gallego (answer, page 3) without specifying why one of ordinary skill in the art would

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it is noted that "the pyrolytic vapor generating module" as recited in claim 20 has no clear antecedent support. Prior to the final disposition of this application, the examiner, with the help of appellant, should review claim 20 and determine whether or not an amendment is necessary to resolve any ambiguity relating to the use of the above-noted term.

have been led by those disclosures to modify the particular apparatus of Riley so as to arrive at the herein claimed subject matter. In this context, the examiner must provide specific reasons or suggestions for combining the teachings and disclosures of the applied secondary references with Riley. *See In re Dembiczak,* 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)("[T]he showing [of evidence of a suggestion, teaching, or motivation to combine] must be clear and particular."). Here, the examiner has not established any convincing reason, suggestion or motivation for combining the references as proposed based on the tachings of the applied references to modify the apparatus of Riley in a manner so as to arrive at the claimed subject matter (see the brief, pages 9-15).[4]

For the foregoing reasons, we determine that the examiner has not established a *prima facie* case of obviousness in view of the reference evidence. Accordingly, we will not sustain either of the examiner's § 103 rejections.

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[4] We note that Sakamoto, Toshiba and Wanlass as applied against dependent claim 26 do not cure the above-noted deficiencies.

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CONCLUSION

The decision of the examiner to reject claims 20-25 and 27 under 35 U.S.C. § 103 as being unpatentable over Riley in view of Rubin, Gallego and Takahashi and to reject claim 26 under

35 U.S.C. § 103 as being unpatentable over Riley in view of Rubin, Gallego and Takahashi and further in view of Sakamoto, Toshiba and Wanlass is reversed.

REVERSED

CHARLES F. WARREN Administrative Patent Judge	)	
THOMAS A. WALTZ Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
PETER F. KRATZ Administrative Patent Judge	)	

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